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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,354	04/04/2001	Addison M. Fischer	264-175	1412

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EXAMINER

MATZ, DANIEL R

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,354

Applicant(s)

FISCHER, ADDISON M.

Examiner

Daniel Matz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-14 and 22-28 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,758,327 granted to Gardner et al.

Regarding claim 1, Gardner et al. disclose system comprising a user (companies 12, 14, 16) and a vendor (24, 26, 28) coupled by a communication system (fig. 1), and a method for performing an electronic transaction between the user and the vendor, comprising: establishing by a user an order list including at least one item to be obtained from the vendor (fig. 2, step 40; col. 5, line 62 – col. 6, line 12); submitting the order list to the vendor over the communication system (fig. 2, step 52, col. 7, lines 12-31); receiving the list by the vendor (fig. 2, step 52, col. 7, lines 12-31); making the list available to the user through a real-time connection with the vendor (col. 7, lines 35-39; note that the user (requestor) has access to the list at any time); establishing a real-time connection between the user and the vendor (col. 4, lines 56-60, use of the Internet and a dedicated site, and thus establishing a real-time connection); and enabling the user to review and approve the order list during the real-time connection (fig. 2, step 54; col. 4, lines 32-48).

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Regarding claim 2, Gardner et al. disclose a method including identifying by the vendor the user who sent the order list and associating the order list with the user (col. 6, lines 9-12; the user (company) identification is included as part of the list).

Regarding claim 3, Gardner et al. disclose a method including enabling the user to modify the order list during the real-time connection and prior to approving the list (col. 3, lines 48-52; the list can be modified (items deleted) and reconsidered prior to approval).

Regarding claim 4, Gardner et al. disclose a method including sending the order list to the vendor using e-mail (col. 3, line 60).

Regarding claims 5-7, Gardner et al. disclose a method including using the Internet and establishing the real-time connection using a browser. Note that Gardner et al. disclose the use of the Internet/World Wide Web (col. 4, lines 56-60), which would inherently include the use of an Internet browser. As to limitations that are considered to be inherent in a reference, note the case law of In re Ludtke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al., 195 USPQ 430, and In re Brown, 173 USPQ 685, 688.

Regarding claim 8, Gardner et al. disclose a method (see above regarding claim 1) for performing an electronic transaction between the user and the vendor, comprising: establishing by a user an order list including at least one item to be obtained from the vendor; submitting the order list to the vendor over the communication system; receiving by the user a confirmation of the order list sent by the vendor (note that the order list is available to the requestor at all times, and thus acts as

a confirmation of the order list); editing the confirmation of the order list by the user to create a modified order list (col. 3, lines 48-52); sending the modified confirmation order list to the vendor (the list is available to the vendor); making the modified confirmation list available to the user through a real-time connection with the vendor (the list is available to the user in real time); establishing a real-time connection between the user and the vendor (see above regarding claim 1); and enabling the user to approve the order list during the real-time connection (see above regarding claim 1).

Regarding claim 9, Gardner et al. disclose a method including identifying by the vendor the user who sent the order list and associating the order list with the user (col. 6, lines 9-12; the user (company) identification is included as part of the list).

Regarding claim 10, Gardner et al. disclose a method including enabling the user to modify the order list during the real-time connection and prior to approving the list (col. 3, lines 48-52; the list can be modified (items deleted) and reconsidered prior to approval).

Regarding claim 11, Gardner et al. disclose a method including sending the order list to the vendor using e-mail (col. 3, line 60).

Regarding claims 12-14, Gardner et al. disclose a method including using the Internet and establishing the real-time connection using a browser (see above regarding claims 5-7).

Regarding claim 22, Gardner et al. disclose a system and method for performing an electronic transaction between the user and the vendor as discussed above regarding claim 1, including parsing the list to extract an order for the vendor. In

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particular as noted in col. 6, lines 5-12, the list (requisition form) includes information on the item or items, the company (user), and other information necessary to extract an order for the vendor is included.

Regarding claim 23, Gardner et al. disclose a system and method further including enabling the user to modify the order during the real-time connection and prior to approving the order (col. 3, lines 48-52; the list can be modified (items deleted) and reconsidered prior to approval).

Regarding claims 24 and 26, Gardner et al. disclose a system and method further including using an automated process (performed by the central computer system, 10; see col. 6, lines 13-26) to parse the list, which would inherently include scanning the list for delimiters indicating order entries in the list.

Regarding claim 25, Gardner et al. disclose a system and method wherein the communications system is the Internet (col. 4, lines 56-60, also see above regarding claims 5-7) and further including using e-mail (col. 3, line 60) to submit the list to the vendor, and inherently disclose using a browser to establish the real-time connection (see above regarding claims 5-7).

Regarding claim 27, Gardner et al. disclose a system and method for performing an electronic transaction between the user and the vendor as discussed above regarding claim 1, including uploading by the user the order list to the vendor (col. 3, lines 60-61; electronic file transfer may be utilized). Note that uploading is a means of electronic file transfer.

Regarding claim 28, Gardner et al. disclose a system and method further including enabling the user to modify the uploaded order list during the real-time connection (col. 3, lines 48-52; the list can be modified (items deleted) and reconsidered prior to approval).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al. as applied to claims 1-7 above, in view of USPN 5,793,972 granted to Shane.

Regarding claims 15-21, Gardner et al. disclose a system and method having all of the claimed limitations (as discussed above regarding claims 1-7) with the exception of including a step of sending a proposed order list by a vendor to a user. Shane teaches (see abstract) a method of sending a proposed order list (e.g., fig. 3, sent via email) from a vendor to a user in order to encourage the user to respond and make a purchase from the vendor. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a step of sending a proposed order list by a vendor to a user into the system and method of Gardner et al. in order to encourage the user to respond and make a purchase from the vendor.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Matz whose telephone number is (703) 306-4164. The examiner can normally be reached on Mon-Thurs, alt Fri 7:30am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4180.

DM

October 22, 2003

MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER